

The opinion in support of the decision being entered today
was *not* written for publication in and is *not* binding
precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte REINER KRAFT and PETER CHI-SHING YIM

Appeal No. 2006-2273
Application No. 09/617,455
Technology Center 3600

ON BRIEF

Decided: February 12, 2007

Before MURRIEL E. CRAWFORD, STUART S. LEVY, and
ANTON W. FETTING, *Administrative Patent Judges*.

ANTON W. FETTING, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1 through 26, which are all of the claims pending in this application.

We AFFIRM and ENTER A NEW GROUND OF REJECTION UNDER
37 C.F.R. § 41.50(b).

BACKGROUND

The appellants' invention dynamically adapts a banner advertisement to the categorization, surrounding page content, and changes of an advertiser's repository. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A system for dynamically adapting an advertisement based on a content of a page, comprising:
 - a keyword analyzer for analyzing the page content;
 - a banner display module for determining a desirability of associating the advertisement with the page; and
 - the banner display module selectively displaying at least a portion of the advertisement if an association between the advertisement and the page is determined to be desirable.

PRIOR ART

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Kurtzman, II (Kurtzman '944)	US 6,144,944	Nov. 7, 2000
Landsman ¹	US 6,314,451	Nov. 6, 2001 (Jul. 13, 1999)

The following art is incorporated by reference within Kurtzman '944

Kurtzman, II (Kurtzman '376)	US 6,044,376	Mar. 28, 2000
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¹ Cited as evidence of notoriety in response to the appellants' traversal of official notice (Answer 9).

REJECTIONS

Claims 1-3, 17, 18, 22 and 23 stand rejected under 35 U.S.C. § 102(e) as anticipated by Kurtzman '944.

Claims 4-16, 19-21 and 24-26 stand rejected under 35 U.S.C. § 103(a) as obvious over Kurtzman '944.

The examiner withdrew the rejection of claims 1-16 and 22-26 35 U.S.C. § 101 (Answer 2).

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's answer (mailed March 8, 2006) for the reasoning in support of the rejection, and to appellants' brief (filed December 8, 2005) and reply brief (filed May 6, 2006) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art reference, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations that follow.

As a procedural matter, we note that the appellants submitted proposed claim amendments (Reply Br. 17) to claims 1-3. These amendments have not been entered, and to the extent the reply brief arguments are directed toward the claims as proposed to be amended, those arguments are not pertinent to the appeal at hand because they are not directed toward the claims at issue.

Claims 1-3, 17, 18, 22 and 23 rejected under 35 U.S.C. § 102(e) as anticipated by Kurtzman '944.

We note that the appellants argue these claims as a group. Accordingly, we select claim 1 as representative of the group.

The issue under contention is whether the banner display module in the art selectively displays at least a portion of the advertisement if an association between the advertisement and the page is determined to be desirable.

The facts pertinent to this issue are:

Kurtzman '944 fully incorporated the contents of Kurtzman '376 (Kurtzman '944, Col. 4, Lines 50-57).

Kurtzman '944 displays an advertisement (Col. 2, Lines 23-25).

Kurtzman '376 displays a floating advertisement that may appear anywhere on a page (Col. 3, Lines 4-5).

An advertisement that may appear anywhere on a page is a species of banners.

Kurtzman 944's content stream engine 116 analyzes the content of the page 179 and attempts to match a corresponding advertisement reflecting the interests of the user. (Col. 4, Lines 50-52).

Kurtzman '376 details how this matching occurs.

FIG. 4 shows how *a page may be dynamically generated* using content stream analysis. The user 200 views a current page 410, which contains links to other pages. When the user decides to follow a link leading to another page, the website server 110 retrieves the new page 420 and *sends it to the affinity server 100*. The affinity server 100 then *selects an advertisement*. This advertisement is sent back to the

website server 110, where it is associated with the new page 420 and sent to the user 200, *where the advertisement and the new page 420 comprises a dynamically generated page 430.*

FIG. 5 is a flowchart of content stream analysis 170, which involves: (1) receiving a group of advertisements from an advertisement bank (block 510); (2) receiving a content stream (block 520), (3) *determining an affinity measure between each advertisement and the content stream* (block 530); and (4) *selecting and presenting an advertisement to the user, based wholly or partially upon these affinity measures* (block 540).

FIG. 6 shows the *determination of an affinity measure between an advertisement and a content stream* (block 610). This involves: (1) *creating an advertisement feature vector for each advertisement* (block 620); (2) *creating a content feature vector for each content file in the content stream* (block 630); (3) *determining a similarity measure between the advertisement feature vector and the content feature vectors* (block 640); and (4) multiplying the similarity measures by a decay factor (block 66); and (5) summing the similarity measures (block 650). (emphasis added).

(Col. 3, Line 58 – Col. 4, Line 19)).

Affinity is a natural attraction, liking or feeling of kinship. (American Heritage Dictionary, 2000).

That which exhibits a natural attraction, liking or feeling of kinship is desirable.

Therefore, an affinity measure also measures desirability.

Therefore, Kurtzman '376's determining of an affinity measure and selecting based upon affinity measures between an advertisement and a page's content stream is a determining of desirability and selecting based upon desirability of the relationship between an advertisement and the pertinent page.

Thus, we must conclude that the banner display module in the art selectively displays at least a portion of the advertisement if an association between the advertisement and the page is determined to be desirable.

The appellants' principal argument is that Kurtzman '944 measures the affinity with the user rather than with the page. (Br. 13-14). The facts of Kurtzman '376, again, incorporated by reference within Kurtzman '944, simply show this is not the only affinity measure. The comparison is also between *the advertisement feature vector and the [page] content feature vectors*. Therefore, we find the appellants' arguments to be unpersuasive.

Accordingly we sustain the examiner's rejection of claims 1-3, 17, 18, 22 and 23 under 35 U.S.C. § 102(e) as anticipated by Kurtzman '944.

Claims 4-16, 19-21 and 24-26 rejected under 35 U.S.C. § 103(a) as obvious over Kurtzman '944.

We note that the appellants argue these claims as a group. Accordingly, we select claim 4 as representative of the group.

The issue under contention is whether the art's banner, displayed according to the limitations of claim 1, displays a static first portion pending retrieval of a second portion.

The facts relevant to this issue are:

The examiner took official notice of the notoriety of displaying fixed messages, such as "Downloading" during a download (Answer 4).

The examiner cited Landsman in response to the appellants' traversal of the official notice (Br. 18; Answer 9).

Landsman describes displaying a static first portion pending retrieval of a second portion of an advertisement during a process referred to as streaming. (Col. 7, Line 65-Col. 8, Line 6).

Therefore, we must conclude Kurtzman '944's banner, displayed according to the limitations of claim 1, displays a static first portion pending retrieval of a second portion.

The appellants' principal argument is that Kurtzman '944 displays the first portion only if the advertisement does not disadvantageously affect the advertiser's image (Br. 15-16; Reply Br. 18-19). This is no more than a repetition of their argument against the rejection of claim 1, and is equally unpersuasive here for the same reasons indicated above.

Accordingly we sustain the examiner's rejection of claims 4-16, 19-21 and 24-26 under 35 U.S.C. § 103(a) as obvious over Kurtzman '944.

NEW GROUND OF REJECTION UNDER 37 CFR § 41.50(B)

Pursuant to 37 CFR § 41.50(b), we enter the following new grounds of rejection: Claims 1-26 are rejected under 35 U.S.C. § 112, rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention.

More particularly, independent claims 1, 17 and 22 each has a limitation in which a display occurs if an association between a page and an advertisement is determined to be desirable. The characterization of "desirable" is totally subjective to each individual obviating any possibility of pointing out the scope of the claims with any degree of particularity.

Reference to undefined standards, regardless of whose views might influence the formation of those standards, fails to provide any direction to one skilled in the art attempting to determine the scope of the claimed invention. *Datamize, LLC v. Plumtree Software, Inc.*, 417 F. 3d 1342; 75 U.S.P.Q.2D 1801 (Fed. Cir. 2005). This noted characterization in these claims so rejected have no objective standards and therefore fails to provide the direction required under 35 U.S.C. § 112, second paragraph, to one skilled in the art attempting to determine the scope of the claimed invention.

Analysis.

Every patent's specification must "conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." 35 U.S.C. § 112, second paragraph. Because the claims perform the fundamental function of delineating the scope of the invention, *Chimie v. PPG Indus., Inc.*, 402 F.3d 1371, 1379 (Fed. Cir. 2005), the purpose of the definiteness requirement is to ensure that the claims delineate the scope of the invention using language that adequately notifies the public of the patentee's right to exclude, *Honeywell Int'l, Inc. v. Int'l Trade Comm'n*, 341 F.3d 1332, 1338 (Fed. Cir. 2003).

According to the Supreme Court, "[t]he statutory requirement of particularity and distinctness in claims is met only when [the claims] clearly distinguish what is claimed from what went before in the art and clearly circumscribe what is foreclosed from future enterprise." *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 236, 63 S. Ct. 165, 1943 Dec. Comm'r Pat. 758 (1942). The definiteness requirement, however, does not compel absolute clarity. Only claims "not amenable to construction" or "insolubly ambiguous" are indefinite. See *Novo*

Indus., L.P. v. Micro Molds Corp., 350 F.3d 1348, 1353 (Fed. Cir. 2003); *Honeywell Int'l*, 341 F. 3d at 1338; *Exxon Research & Eng'g Co. v. United States*, 265 F.3d 1371, 1375 (Fed. Cir. 2001). Thus, the definiteness of claim terms depends on whether those terms can be given any reasonable meaning. Furthermore, a difficult issue of claim construction does not ipso facto result in a holding of indefiniteness. *Exxon Research & Eng'g*, 265 F. 3d at 1375. "If the meaning of the claim is discernible, even though the task may be formidable and the conclusion may be one over which reasonable persons will disagree, we have held the claim sufficiently clear to avoid invalidity on indefiniteness grounds." *Id.*

In the face of an allegation of indefiniteness, general principles of claim construction apply. See *Oakley, Inc. v. Sunglass Hut Int'l*, 316 F.3d 1331, 1340-41 (Fed. Cir. 2003) (noting that a determination of definiteness "requires a construction of the claims according to the familiar canons of claim construction"). Intrinsic evidence in the form of the patent specification and file history should guide a court toward an acceptable claim construction. *Phillips v. AWH Corp.*, 415 F.3d 1303, (Fed. Cir. July 12, 2005) (en banc).

We first look to the intrinsic record to determine whether there is any objective standard for these claim terms. The specification states

In operation, and with further reference to FIG. 4, the web page 150 is rendered and displayed to the user at step 405. While the user is browsing the web page 150, the keyword analyzer 210 analyzes the page content at step 410. At decision step 415, the banner display module 200 of the adaptive advertising system 10 *determines the desirability of associating* this page 150 with the banner advertisement 160 assigned by the server 15 for display in conjunction with the page 150. (emphasis added)

(Spec 16).

Thus, module 200 makes the determination at step 415, but the specification provides no teaching of the criteria for the determination. The specification only describes how, once the subjective evaluation of desirability is completed, the system will decide whether to display a banner (Spec. 8; 16).

As to prosecution history, this issue arose earlier, but, although the issue was subsequently dropped, it was not resolved and is properly resurfaced. The issue was initially raised by the examiner for the subjective recitation of the characterization of desirability, along with an issue of enablement under the first paragraph of 35 U.S.C. § 112, in the non-final rejection mailed Oct. 3, 2003, pp. 7-8. The appellants responded to the 35 U.S.C. § 112, first paragraph, but not the second paragraph, rejection in their response filed Jan. 2, 2004. The examiner maintained the rejection in the final rejection mailed Feb. 19, 2004. The appellants responded by appealing the final rejection, and answering the rejection under 35 U.S.C. § 112, second paragraph in a brief filed Jul. 19, 2004.

Regarding the second rejection ground, Applicants incorporate by reference the presentation made earlier in favor of allowance of the claims over the rejection under 35 U.S.C. 112, first paragraph, and reiterate that the use of subjective terms is proper, both under 35 U.S.C. 112, first and second paragraphs.

(Jul. 19, 2004 Br. 16).

Thus, the appellants contended that the 35 U.S.C. § 112, second paragraph issue was answered because the specification enabled the claims.

However, enablement is entirely different from specificity. The appellants argued enablement as follows.

The Examiner further based his rejection on the following ground: The recited claim terms "desirability," "desirable," "inappropriate," or "disadvantageously" are subjective terms that are considered non enabling to those skilled in the art." Applicants submit that this objection does not constitute a proper rejection ground under 35 USC 112, First Paragraph. Applicants further submit that:

(1) The fact that the terms are subjective does not render the invention non-enabled. Does the Examiner mean that any subjective term renders the claims objectionable under 35 USC 112, First Paragraph? Applicants have requested the Examiner to provide the legal ground in support of the rejection ground that subjective terms cannot be properly used in the claims and that the claims containing subjective claims are automatically rejected under 35 USC 112, First Paragraph. The Examiner has not provided the requested supported legal ground or authority.

(2) These "subjective" terms have been used and described in the specification in a very objective context, and thus these terms should be interpreted in their proper context as opposed to their general meaning. As an example, the term "desirability" that is used in claim 1 refers to a material factor that could be reflected by a value (or number) that is fed to the banner display module in order to determine if it is acceptable (or desirable) to associate the advertisement with the page. (emphasis in original)

(Jul. 19, 2004 Br. pp. 14 and 15).

Thus, the appellants argue that one way to implement the attribute of desirability is by assigning a numeric value, and that having shown an implementation, the claim limitation of desirability is rendered objective, and thus definite.

Showing one way to implement this feature, and thus enable that implementation, in no way circumscribes the metes and bounds of what is meant

by “desirable.” This implementation merely assigns the programmer’s tastes to setting criteria for desirability, as manifest in the programmer’s computer code that assigns the numbers the appellants refer to. Creating a numeric scale for subjective evaluation does not render the evaluation objective, it merely renders it discrete in representation. It still begs the question of what the criteria of desirability are for each number assigned. So long as these criteria are themselves subjective, the characterization of desirability lacks an objective standard.

This issue was dropped from the next non-final rejection, mailed Sep. 17, 2004, with no explanation by the examiner. Thus, the only suggestion in the record as to the standard to be applied to desirability is the number assigned by the program as written by the individual programmer or programming team. This, again, is a subjective basis, albeit one that is measured by numbers.

Hence there is no objective test disclosed for the scope of the criteria that an association might exhibit to be desirable. As the opinion in *Datamize* (where the subjective element was the phrase “aesthetically pleasing”) stated

The scope of claim language cannot depend solely on the unrestrained, subjective opinion of a particular individual purportedly practicing the invention. See *Application of Musgrave*, 431 F.2d 882, 893 (C.C.P.A. 1970) (noting that “[a] step requiring the exercise of subjective judgment without restriction might be objectionable as rendering a claim indefinite”). Some objective standard must be provided in order to allow the public to determine the scope of the claimed invention. Even if the relevant perspective is that of the system creator, the identity of who makes aesthetic choices fails to provide any direction regarding the relevant question of how to determine whether that person succeeded in creating an “aesthetically pleasing” look and feel for interface screens. A purely subjective construction of “aesthetically pleasing” would not notify the public of the patentee’s right to exclude since the meaning of the claim language would depend on the unpredictable vagaries of any one

person's opinion of the aesthetics of interface screens. While beauty is in the eye of the beholder, a claim term, to be definite, requires an objective anchor. . . .

Reference to undefined standards, regardless of whose views might influence the formation of those standards, fails to provide any direction to one skilled in the art attempting to determine the scope of the claimed invention. In short, the definition of "aesthetically pleasing" cannot depend on the undefined views of unnamed persons, even if they are experts, specialists, or academics.

Datamize at 1350-1352

We note that the standards of desirability are no more objective than a standard for aesthetic pleasure. Both are highly dependent on geographic, cultural, and personal history vagaries of the people to whom such criteria apply.

Therefore, because, as the court stated in *Datamize*, the definition of a claim limitation cannot depend on the undefined views of unnamed persons, we reject claims 1-26 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention.

CONCLUSION

To summarize,

- The rejection of claims 1-3, 17, 18, 22 and 23 under 35 U.S.C. § 102(e) as anticipated by Kurtzman '944 is sustained.
- The rejection of claims 4-16, 19-21 and 24-26 under 35 U.S.C. § 103(a) as obvious over Kurtzman '944 is sustained.
- A new rejection of claims 1-26 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention is made under 37 CFR § 41.50(b).

Regarding the affirmed rejection(s), 37 CFR § 41.52(a)(1) provides "[a]ppellant may file a single request for rehearing within two months from the date of the original decision of the Board."

In addition to affirming the examiner's rejection(s) of one or more claims, this decision contains new grounds of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50 (b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record

Should the appellants elect to prosecute further before the examiner pursuant to 37 CFR § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellants elect prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

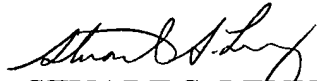
No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED
AND
NEW GROUND OF REJECTION UNDER 37 CFR § 41.50(b)



MURRIEL E. CRAWFORD

Administrative Patent Judge



STUART S. LEVY

Administrative Patent Judge



ANTON W. FETTING

Administrative Patent Judge

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